

R E M A R K S

Based on the Restriction Requirement set forth in the April 14, 2006 Office Action and applicants' RESPONSE TO RESTRICTION REQUIREMENT dated April 26, 2006, the Examiner examined claims 1 to 10 and 23, and withdrew claims 11 to 22 and 24 to 28 from consideration (see the "Election/Restrictions" on pages 2 to 4 of the Office Action).

In the last full paragraph on page 3 of the Office Action, it is stated that the Examiner has withdrawn the restriction requirement between Group I (compounds of formula 1 where B is a purine base) and Group II (compounds of formula 1 where B is a pyrimidine base).

Contrary to the last full statement on page 3 of the Office Action, Group II (not Group I) was elected.

Claims 23 to 28 were included in elected Groups I and II. Therefore, claims 23 to 28 should not have been withdrawn and should have been examined.

It is therefore respectfully requested that claims 23 to 28 be examined.

Minor editorial revisions were made hereinabove to claims 1 to 6, 11, 19 and 23.

The definition of R² in claim 1 was amended to reply to the objection set forth on page 2 of the Office Action.

The amendment to claim 22 is supported on page 64, lines 21 to 22 of the specification.

Claims 1 to 10 and 23 were rejected under 35 USC 112, second paragraph, for the reasons set forth on pages 4 to 5 of the Office Action.

Claim 1 was amended by following the Examiner's suggestions. Withdrawal of the 35 USC 112, second paragraph rejection is thus respectfully requested.

The Office Action enclosed copies of the INFORMATION DISCLOSURE STATEMENTS BY APPLICANT Form PTO/SB/08A and Form PTO/SB/08B dated April 19, 2002; Form PTO/SB/08A dated March 9, 2004; and Form PTO/SB/08A dated April 1, 2004. The Examiner's initials are in the left column next to each cited publication, except for the following non-patent literature documents: the first publication on sheet 1 of Form PTO/SB/08B dated April 19, 2002, the second publication on sheet 5 of Form PTO/SB/08B dated April 19, 2002, the first publication on sheet 8 of the Form PTO/SB/08B dated April 19, 2002; the penultimate publication listed on sheet 10 of Form PTO/SB/08B dated April 19, 2002; and the first document ("9/925,673") cited on sheet 1 of Form PTO/SB/08A dated April 19, 2002.

Although the Examiner drew a line through "09/925,673" on sheet 1 of the Form PTO/SB/08A dated April 19, 2002, the Examiner initialled the corresponding U.S. patent publication (US 2002/0147332) on the Form PTO/SB/08A dated April 1, 2004.

Enclosed are copies of the following non-patent documents that were not initialled by the Examiner:

Maher et al., Cancer Investigation, (1996), 14(1), 66-82;
Surzhykov et al., Nucleosides and Nucleotides, 13(10), 2283-2305 (1994); and

Berkow et al., eds., The Merck Manual of Diagnosis and Therapy, 15th Ed., Rahway, N.J., (1987), 2301-2310.

The Examiner is respectfully requested to return copies of the fully initialled Forms PTO/SB/08B which cite the aforesaid

three publications, so that such publications will be considered and made of record.

The above-identified application is a CIP of International application PCT/JP00/04902 filed July 21, 2000.

Regarding the first paragraph on page 2 of the Office Action which refers to 37 CFR 1.55 and MPEP 201.15, submitted concomitantly herewith are the following:

(1) an English-language translation of International application PCT/JP00/04902 filed July 21, 2000, along with a STATEMENT OF ACCURACY OF TRANSLATION signed by Mr. Takamitsu Yoneda on August 18, 2006; and

(2) an English-language translation of applicants' Japanese priority application 11-207170 filed July 22, 1999, along with a STATEMENT OF ACCURACY OF TRANSLATION signed by Mr. Takamitsu Yoneda on August 18, 2006.

Claims 1 to 10 and 23 were rejected under 35 USC 102 as being anticipated by Obika et al. ("Synthesis of a conformationally locked AZT analogue, 3'-azido-3'-deoxy-2'-O,4'-c-methylene-5-methyluridine", Tetrahedron Letters, 40, 6465-6468, 1999).

A copy of the cover sheet of Vol. 40 of Tetrahedron Letters (1999) is enclosed, which shows a date of August 27, 1999 and also shows that the Obika et al. Tetrahedron Letters publication was received in the library of the assignee on September 1, 1999.

The Obika et al. publication was thus published within one year of applicants' International application filing date.

It is respectfully submitted that the rejected claims are supported by the claims in International application

PCT/JP00/04902, and therefore applicants should be entitled to a filing date of July 21, 2000.

Applicants have informed the undersigned that Obika et al. is a publication of applicants' invention.

Submitted concomitantly herewith is a DECLARATION UNDER 37 CFR 1.132 THAT INVENTORS NAMED IN THIS APPLICATION CONCEIVED AND INVENTED THE SUBJECT MATTER OF THIS APPLICATION WHICH IS DISCLOSED IN THE CITED PUBLICATION, signed by inventors Takeshi IMANISHI and Satoshi OBIKA on September 20, 2006.

In view of the above, since Obika et al. was published less than one year before applicants' International filing date and is a publication of applicants' own invention, removal of Obika et al. as a reference is respectfully requested (see MPEP 715.01 (c), Ex parte Lemieux, 115 USPQ 148 and In re Katz, 215 USPQ 14).

Withdrawal of the 35 USC 102 rejection is therefore respectfully requested.

Reconsideration is requested. Allowance is solicited.

An INFORMATION DISCLOSURE STATEMENT is being filed concomitantly herewith.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,



Richard S. Barth
Reg. No. 28,180

Frishauf, Holtz, Goodman & Chick, P.C.
220 Fifth Avenue - 16th Floor
New York, New York 10001-7708
Tel. No. (212) 319-4900
Fax No. (212) 319-5101
E-mail Address: BARTH@FHGC-LAW.COM
RSB/ddf

- Enclosures: (1) copies of the following IDS publications:
Maher et al., Surzhykov et al. and
Berkow et al.
- (2) English-language translation of PCT/JP00/04902,
along with a STATEMENT OF ACCURACY OF TRANSLATION
 - (3) English-language translation of JP 11-207170,
along with a STATEMENT OF ACCURACY OF TRANSLATION
 - (4) cover sheet of Tetrahedron Letters, Vol. 40
(1999)
 - (5) DECLARATION UNDER 37 CFR 1.132 THAT INVENTORS
NAMED IN THIS APPLICATION CONCEIVED AND INVENTED
THE SUBJECT MATTER OF THIS APPLICATION WHICH IS
IS DISCLOSED IN THE CITED PUBLICATION
 - (6) INFORMATION DISCLOSURE STATEMENT